

**REMARKS**

Claims 1-15 are pending in the application.

Claims 1-15 have been rejected.

Claims 1, 4-11 and 13-15 have been amended. These claims have been amended, in part, to correct formal matters and, in part, to clarify distinctions between the disclosure of the cited references and the present invention. Applicants submit that no new matter has been added by these amendments and, unless explicitly discussed below, the changes are not believed to alter the scope of the claims. Applicants further submit that support for the amendments can be found at least at pages 8, 11 and 13 of the original Application.

**Rejection of Claims Under 35 U.S.C. §101**

Claims 6-10 stand rejected under 35 U.S.C. §101 because the claimed invention is purportedly directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

Independent Claim 6 has been amended to include a limitation of the following form: “wherein the machine readable medium comprises any medium configured to store data or information, or encoding a sequence of instructions and operations for execution by the processor, and is other than a carrier-wave signal.” Applicants respectfully submit that this amendment, explicitly excluding carrier-wave signals, is responsive to the rejection in the Office Action.

Applicants do not, however, concede that current decisions from the Court of Appeals for the Federal Circuit demand that carrier wave signals are non-statutory *per se*.

Applicants therefore reserve the right to present claims directed to carrier-wave media at a future date, for example, in a continuation application.

*Rejection of Claims Under 35 U.S.C. §103*

Claims 1-3, 5-11, 13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,496,835 issued to Liu (“Liu”) in view of U.S. Patent 6,889,260 issued to Hughes (“Hughes”). Applicants respectfully traverse this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Independent Claims 1, 6 and 11 have been amended with a clarifying limitation presenting, substantially, “mapping the source element to the destination element, wherein ... executing said mapping ... maintains the data only in the first location of the structured environment.” *See, e.g.*, Claim 1 (as amended) (emphasis added). Applicants respectfully submit that Liu’s mapping does not envision data being maintained only in a first location.

In fact, Liu discloses that the mapped data is transmitted to a portable device via a synchronization process that purportedly uses Liu’s disclosed mapping. *See, e.g.*, Liu

1:49-55, 5:12-21. Liu is not capable of performing its disclosed function without providing at least a copy of the mapped data to a storage in the disclosed portable device.

Hughes is not cited by the Office Action as providing Liu's missing disclosure. In fact, the disclosure of Hughes also teaches away from maintaining the data only in a first location.

Hughes discloses a mechanism for purportedly building a metadata packet that defines a data structure, a record, or another collection of related data. *See* Hughes 2:15-25. Hughes discloses building the metadata packets in order to transfer data between applications having heterogeneous data structures. *See* Hughes 1:62-2:2. Applicants respectfully submit that this building of metadata packets to transfer data is incompatible with the claim limitation maintaining the data only in the first location, since the purpose of the metadata packet is to convert and transport the data to a new application and location.

For the reasons presented above, neither Liu or Hughes, alone or in combination, teaches the "maintaining the data only in the first location" limitation of the independent claims. The burden is on the Examiner to support a case of obviousness, including whether the prior art references teach or suggest all of the claim limitations. *See* MPEP 706.06.02(j).

In addition, Applicants also respectfully submit that the Office Action has not satisfied the burden of factually supporting the alleged motivation to combine the two references. This duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Examiner must therefore provide evidence to suggest the combination and "[b]road conclusory statements regarding the teaching of multiple references,

standing alone, are not ‘evidence.’” *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Applicants respectfully submit that while Liu and Hughes both are related generally to transferring data, there is no motivation to combine the references because they present very different environments. Liu discloses a purported mechanism for mapping of data fields to facilitate the transfer of data from a desktop computing system to a portable computing system. *See, e.g.*, Liu 2:43-67. Hughes, on the other hand, discloses a purported mechanism for providing a metadata packet to facilitate application-to-application data exchange that enables a data conversion from a format of a source application to a format of a destination application. *See, e.g.*, Hughes, Abstract. There is no indication in Liu that a metadata packet, such as that disclosed in Hughes, is necessary nor desirable. In fact, Liu presents little, if any, disclosure related to the actual transfer of data from the desktop computing environment to the portable computing environment, and so, as one of ordinary skill in the art would appreciate, is agnostic to the means of data transfer. On the other hand, Hughes provides little to no indication of mapping data from the source application to data in the destination application, or how that information may be included in the metadata packet.

For these reasons, Applicants respectfully submit that there is no motivation to combine disclosed within the references themselves. Further, the Office Action makes no showing of a motivation to combine Liu with Hughes from within the references themselves; therefore, it must be presumed that there is none. A showing of combinability must be “clear and particular” and “broad conclusive statements about the teaching of multiple references, standing alone, are not ‘evidence.’” *See Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson*, 229 F.3d at 1125.

Applicants further respectfully submit that even were a motivation to combine be found within the references themselves, a proposition with which Applicants do not concede, the combination of Liu with Hughes would not successfully implement the presently claimed invention. As stated above, neither Liu nor Hughes provide disclosure of the claim limitation in which the execution of the claimed mapping from the source to the destination maintains the data only in the first location of the structured environment.

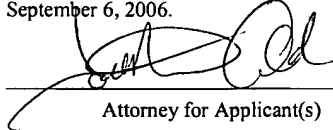
Applicants further submit that Hughes is also incompatible with the claim limitation “executing said mapping provides an unchanged image of data mapped to the first source field to the first destination field for display on the second user interface.” Hughes discloses that “the process engine converts the received purchase order data structure in the format of the source application into the structure compatible with the order entry input of the target.” Hughes 11:42-45. This conversion of data from the purchase order data structure to the target order entry data structure clearly does not provide an “unchanged” image of the data, as recited by the claimed invention. But such conversion of data is clearly required by Hughes and therefore any combination of Hughes with Liu must include data conversion. For at least these reasons, Applicants respectfully submit that a combination of Liu with Hughes would not result in a successful implementation of the claimed invention.

For these reasons, Applicants respectfully submit that the Office Action fails to present *prima facie* case of obviousness of independent Claims 1, 6 and 11, and all claims dependent upon them, and that they are in condition for allowance. Applicants therefore respectfully request the Examiner’s reconsideration and withdrawal of the rejections to those claims, and an indication of the allowability of same.

**CONCLUSION**

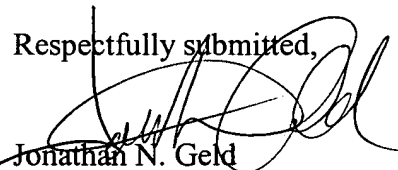
In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, COMMISSIONER FOR PATENTS, P. O. Box 1450, Alexandria, VA 22313-1450, on September 6, 2006.

  
\_\_\_\_\_  
Attorney for Applicant(s)

9/6/2006  
\_\_\_\_\_  
Date of Signature

Respectfully submitted,

  
Jonathan N. Geld  
Attorney for Applicants  
Reg. No. 44,702